

pending (and the ancestor applications listed in the Information Disclosure Statement filed concurrently herewith).

**DOUBLE PATENTING REJECTION - TRAVERSED/NOT SUPPORTED**

No proper statement of rejection is made of Claims 29-61 in the 26 August 2004 Office Action. However, from the case law and remarks given in Item 1, it appears that Claims 29-61 are rejected under the non-statutory obviousness-type doctrine of double patenting based on US 6,701,471 B2.

The presumed non-statutory double patenting rejection is respectfully traversed because such rejection does not provide any factual analysis whatsoever, including the analysis required for such rejections under U.S. patent law, i.e., the Examiner has not satisfied his/her initial burden to adequately support the rejection.

More particularly, MPEP §804 states:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 USC 103 are employed when making an obviousness-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of non-obviousness.

Any obviousness-type double patenting rejection should make clear:

- (A) The **differences** between the invention defined by the conflicting claims-a claim in the patent compared to a claim in the application; and
- (B) The **reasons** why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the patent claims.

The rejection does not make any comparison at all between at least one of the present claims and one of the issued claims, does not make clear any differences, and does not give any reason whatsoever why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Furthermore, the Action states, "Claim(s) 1-33 of patent #6,701,471 contain(s) every element of claim(s) 29-61 of the instant application and as such anticipate(s) claim(s) 29-61 of the instant application" [sic.]. No further comment is made, and no other statement regarding the rejection of the claims is given other than broad statements from decisions in obviousness-type double patenting cases. Applicant respectfully traverses the statement that the issued claims contain every element of pending Claims 29-61 because no comparison is made of the features/limitations of the pending claims and the issued claims as required by MPEP §804.

Accordingly, Applicant respectfully submits that the above analysis should be provided in order for the Examiner to satisfy his/her initial burden to support the rejection, or the rejection should be withdrawn.

#### **NON-STATUTORY DOUBLE PAT. REJ. - TERMINAL DISCLAIMER FILED**

The apparent obviousness-type double patenting rejection of Claims 29-61 as set forth at Item 1 on page 2 of the Office Action is respectfully traversed. However,

in order to travel a path of least resistance to obtaining a patent for the present application, submitted herewith is an executed Statutory (Terminal) Disclaimer to overcome the non-statutory double patenting rejection. As a result of the foregoing, reconsideration and withdrawal of the double patenting rejection of the subject claims are respectfully requested. The above statements, or the filing of any Disclaimer, should not be taken as an indication or admission that the rejection was valid, but is merely use of a procedural approach to obviate the rejection. Further, at this point, it is respectfully submitted as a reminder that, if new art is now cited against any of Applicant's unamended claims, it would not be proper to make a next Action final.

#### **ALL CLAIMS IN CONDITION FOR ALLOWANCE**

In view of the fact that a Disclaimer is filed to obviate the double-patenting rejection, and no rejection of the claims is made based on prior art, it is respectfully submitted that all presently pending claims are now in condition for allowance, and a Notice of Allowance with respect to the present application is respectfully requested.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to

any/all limitations/features not yet claimed, i.e., Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### **CONCLUSION**

This Response is being filed within the shortened statutory period for response set by the 26 August 2004 Office Action, and therefore, no Petition or extension fee is required. To whatever other extent is necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Attached is a Form PTO-2038 including the requisite fee for the attached Disclaimer and the concurrently-filed IDS. Please charge any actual deficiency in fees to ATSK Deposit Account No. 01-2135 (as Case No. 501.34466CC4).

Respectfully submitted,



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**ATTACHMENTS:**

Statutory (Terminal) Disclaimer  
Form PTO-2038 (Fee Codes 1806/1814)